

Appl. No. 10/623,293  
Amdt. dated October 27, 2005  
Reply to Office Action of July 14, 2005

### REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Office Action dated July 14, 2005. Claims 1-4, 6-15, and 17-20 are pending in the application. By this Response, claims 1, 12, 17, 18, and 20 are amended, and claims 5 and 16 are cancelled. Please note that the amendments to claims 17, 18, and 20 are to amend dependency. The Examiner has rejected claims 1, 3-6, 9, 16, and 20 under 35 U.S.C. § 102 as being anticipated by Speranza et al., U.S. Patent No. 5,001,267 ("*Speranza* '267"). The Examiner has also rejected claims 2, 7-8, 10-15, and 17-19 under 35 U.S.C. § 103 as being unpatentable over *Speranza* '267 in combination with Tahara et al., U.S. patent No. 4,373,107 ("*Tahara*") and further in view of Oude Alink et al., U.S. Patent No. 3,994,975 ("*Oude Alink*") and Speranza et al., U.S. Patent No. 3,110,732 ("*Speranza* '732"). Applicants believe the pending claims are allowable over the art of record and respectfully request reconsideration and allowance of all claims.

**I. Claims 1, 3, 4, 6, 9, and 20 are not anticipated by *Speranza* '267.**

The Examiner has rejected claims 1, 3-6, 9, 16, and 20 as being anticipated by *Speranza* '267. By this Response, claims 5 and 16 have been cancelled. Applicants respectfully traverse the Examiner's rejections of claims 1, 3, 4, 6, 9, and 20 as being anticipated by *Speranza* '267. Applicants submit that such claims are not anticipated by *Speranza* '267 because *Speranza* '267 fails to disclose each and every limitation of these rejected claims.

Claim 1 is an independent claim upon which claims 3, 4, 6, and 9 depend. Claim 1 as amended recites "wherein the secondary amine product is produced in a yield of at least 97.00% by weight based on all amine products produced." Nothing in *Speranza* '267 discloses wherein the

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secondary amine product is produced in a yield of at least 97.00% by weight based on all amine products produced. The Examiner indicates that "Speranza et al disclose a process for producing a secondary amine product which comprises heating hydrogen . . . to produce a product of purity of more than 99%." (Office Action, pg. 3, lns. 13-16) Applicants respectfully submit that *Speranza '267* does not teach such a process producing a secondary amine product having a "product of purity of more than 99%" but instead teaches a process producing a much lower yield of secondary amine product. For instance, the highest yield of diisopropyl EDA product *Speranza '267* discloses in the reaction products is 38.2 %. (*Speranza '267*, Table III, Run 6380-67-3) Applicants would like to respectfully point out that the "product of purity of more than 99%" noted by the Examiner is the result of *Speranza '267* teaching **distillation** of the reaction products to separate the various products into fractions and not of the secondary amine product yield in the reaction product produced. For instance, *Speranza '267* teaches "[d]istillation of the reaction products formed by the continuous reactions into fractions indicate that N-iso-propyl ethylenediamine **can be recovered from the reaction product** with a purity of 99% or more." (*Speranza '267*, col. 8, lns. 22-25) Therefore, *Speranza '267* does not teach or suggest "wherein the secondary amine product is produced in a yield of at least 97.00% by weight based on all amine products produced."

In view of the recitations in claim 1 that are neither taught nor suggested by *Speranza '267*, the Applicants respectfully request that the Examiner withdraw the § 102 rejection and allow claim 1. Applicants further request that the Examiner also withdraw the § 102 rejections of dependent claims 3, 4, 6, and 9 since it is submitted that independent claim 1 is allowable. Dependent claims

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3, 4, 6, and 9 must *a fortiori* also be allowable, since they carry with them all the limitations of the independent claim to which they ultimately refer.

Please note that claim 20 has been amended to be dependent upon independent claim 12. As the Examiner has not rejected independent claim 12 as being anticipated by *Speranza '267*, Applicants respectfully request the Examiner to remove the rejection and allow claim 20.

**II. Claims 2, 7-8, 10-15, and 17-19 are patentable over *Speranza '267* in combination with *Tahara* and further in view of *Oude Alink* and *Speranza '732*.**

Applicants respectfully traverse the Examiner's rejections of claims 2, 7-8, 10-15, and 17-19 under § 103 as being unpatentable over *Speranza '267* in combination with *Tahara* and further in view of *Oude Alink* and *Speranza '732*. Applicants submit that, contrary to MPEP § 2143, the Examiner has failed to make a *prima facie* case of obviousness in rejecting the claims in that the Examiner has failed to cite references that teach or suggest all of the elements recited in the rejected claims.

Claims 2, 7-8, and 10-11 are dependent upon independent claim 1. Claim 12 is an independent claim upon which claims 13-15 and 17-19 depend. Claims 1 and 12 as amended recite "wherein the secondary amine product is produced in a yield of at least 97.00% by weight based on all amine products produced." As pointed out in Section I above, nothing in *Speranza '267* teaches or suggests wherein the secondary amine product is produced in a yield of at least 97.00% by weight based on all amine products produced. These missing limitations cannot be supplied by *Tahara*, *Oude Alink*, or *Speranza '732*. Nothing in *Tahara*, *Oude Alink*, or *Speranza*

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'732 teach or suggest wherein the secondary amine product is produced in a yield of at least 97.00% by weight based on all amine products produced.

Applicants therefore respectfully submit that the Examiner has failed to articulate a *prima facie* case of obviousness in rejecting claims 2, 7-8, 10-15, and 17-19, because, contrary to MPEP § 2143, the Examiner has failed to cite references that teach or suggest all of the elements recited in the rejected claims. Since independent claims 1 and 12 are submitted to be allowable, dependent claims 2, 7-8, 10-11, 13-15, and 17-19 must *a fortiori* also be allowable, since they carry with them all the limitations of such independent claims.

### **III. Conclusion**

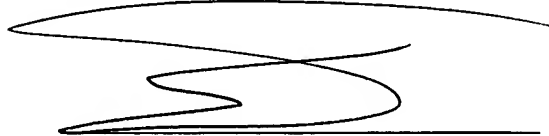
Applicants respectfully request reconsideration, allowance of the pending claims and a timely Notice of Allowance be issued in this case. If the Examiner feels that a telephone conference would expedite the resolution of this case, the Examiner is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art that have yet to be raised, but which may be raised in the future.

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If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Tod T. Tumey', written over a horizontal line.

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